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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/265,493	03/09/1999	DAVID C. TANNENBAUM	MSFT-1167/191769.01	4578

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PHILADELPHIA, PA 19104-2891

EXAMINER

BRIER, JEFFERY A

ART UNIT	PAPER NUMBER
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2628

MAIL DATE	DELIVERY MODE
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01/07/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/265,493	<b>Applicant(s)</b> TANNENBAUM, DAVID C.	
	<b>Examiner</b> Jeffery A. Brier	<b>Art Unit</b> 2628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. The amendment filed on 10/18/2007 has been entered.

### ***Response to Arguments***

2. Applicant's arguments on page 6 concerning claims 1, 10 and 15 filed 10/18/2007 and amendments to these claims filed 10/18/2007 have been fully considered but they are not persuasive because the claims cover any parameter that can be produced from an algorithm including the parameters that selects textures such as the parameter that selects brick wall texture 50 and the parameter that selects paint texture 50, see Lauzon at column 4 lines 50-58, or including the parameters that selects the texture map, see Lathrop mip map selection 28. Applicant needs to clarify in the claim the claimed parameters. Therefore, the previous prior art rejection could be maintained, however, in view of indefinite issues the art rejection will be reserved for later consideration when the claims have been clarified by appropriate claim amendments. Also note Peercy et al, US Patent No., 5,880,736, teaches at column 13 lines 23-40 and at column 23 lines 20-36 using a texture map to obtain the N values for use in a lighting equation.
3. The argument concerning the objection to the specification is not persuasive because the list of parameters on pages 4 and 5 includes "outward surface normal vector at the pixel" while claim 6 with reference to claim 3 lists a surface normal vector. A parameter for a pixel discussed in the background of the invention at pages 4 and 5 is

different than a parameter for a vertex discussed in the detailed specification at page 12, thus, the background description cannot be used to provide proper antecedent basis for the claimed subject matter due to the differences in words used in the claim and the background of the invention.

### ***Specification***

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The limitation found in claims 6, 12, and 16 "a surface normal vector" is not found in the specification, refer to applicants specification at page 12 last line to page 13 line 4. Applicant may be able to add "a surface normal vector" to the list of per-primitive parameters listed at page 12 last line to page 13 line 4.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1:

The parameters included in the claim that defines a pixel value is unclear since a value that selects a texture is a parameter that defines a pixel. Applicant needs to clarify in the claim the claimed parameter.

The substituting step claims "in place of a pixel value produced from an algorithm that uses the selected parameters" is unclear since the texture value is being substituted for a value that is used in the lighting equation rather than produced by the lighting equation. Note lines 8 and 13 refer to the same pixel value. Additionally this step is unclear because it claims to use one "texture value" "in place of a pixel value" at line 8 while line 13 determines the pixel value from parameters including more than one texture value. Applicant needs to clarify in the claim the claimed substitution.

In view of amended line 8 and line 13 the determining a texture value step is unclear since in its second line "the texture value for each selected parameter" is claimed which is unclear since at lines 8-9 one texture value is claimed for a "pixel value" and at lines 13-15 more than one texture value is claimed for a "pixel value".

Thus, the metes and bounds of the claim is unclear.

Claim 9:

This claim is unclear since the lighting equation is not being used to determine the pixel value of parent claim 1 and in view of lines 8-9 and 13-15 the light value for the pixel value is unclear.

Claims 2-9:

The dependent claims of claim 1 do not correct the indefinite issues of claim 1.

Claim 10:

The parameters included in the claim that defines a pixel value is unclear since a value that selects a texture is a parameter that defines a pixel. Applicant needs to clarify in the claim the claimed parameter.

At line 8 "each selected parameter corresponding to a selected parameter" is circular language that does not clearly claim the set of selected parameters at lines 7 and 8. Lines 8-9 and lines 10-11 have the same language, thus, the later does not clearly add a further limitation to the claim.

Thus, the metes and bounds of the claim is unclear.

Claim 14:

This claim is unclear since the lighting equation is not being used to determine the pixel value of parent claim 10.

Claims 11-14:

The dependent claims of claim 10 do not correct the indefinite issues of claim 10.

Claim 15:

This claim is a means plus function version of method claim 1.

The parameters included in the claim that defines a pixel value is unclear since a value that selects a texture is a parameter that defines a pixel. Applicant needs to clarify in the claim the claimed parameter.

At line 13 this claim does not clearly claim a means performing the claimed step. The substituting step claims "in place of a pixel value produced from an algorithm that uses the selected parameters" is unclear since the texture value is being substituted for

a value that is used in the lighting equation rather than produced by the lighting equation. Note lines 13-14 and 18-19 refer to the same pixel value. Additionally this step is unclear because it claims to use one "texture value" "in place of a pixel value" at line 13 while line 18 determines the pixel value from parameters including more than one texture value. Applicant needs to clarify in the claim the claimed substitution.

In view of amended lines 13-14 and line 18 the determining a texture value function at lines 15-17 is unclear since in its second line "the texture value for each parameter" is claimed which is unclear since at lines 13-14 one texture value is claimed for a "pixel value" and at lines 18-20 more than one texture value is claimed for a "pixel value".

Thus, the metes and bounds of the claim is unclear.

Claim 18:

This claim is unclear since the lighting equation is not being used to determine the pixel value of parent claim 15 and in view of lines 13-14 and 18-20 the light value for the pixel value is unclear.

.Claims 16-20:

The dependent claims of claim 15 do not correct the indefinite issues of claim 15.

7. A proper prior art analysis of the claims cannot be made because the metes and bounds of the claims are not definite and because the specification does not clarify the claims. Thus, a prior art rejection or an indication of allowability cannot be made with the currently pending claims. In re Steele, 305 F.2d 859, 134 USPQ 292 (CCPA 1962)

(it is improper to rely on speculative assumptions regarding the meaning of a claim and then base a rejection under 35 U.S.C. 103 on these assumptions).

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery A Brier whose telephone number is (571) 272-7656. The examiner can normally be reached on M-F from 7:30 to 4:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Razavi, can be reached at (571) 272-7664. The fax phone Number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.



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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jeffery A. Brier/  
Primary Examiner, Division 2628